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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,355	07/09/2001	Peter B. Dervan	025098/2802	6306

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EXAMINER

RAWLINGS, STEPHEN L

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 10/03/2003

12

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/807,355

**Applicant(s)**

DERVAN, PETER B.

**Examiner**

Stephen L. Rawlings, Ph.D.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 June 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-24 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: *election facsimile cover sheet*.

### **DETAILED ACTION**

1. The amendment filed June 10, 2002 is acknowledged and has been entered.
2. Claims 1-24 are pending in the application and are currently subject to the following restriction.

#### ***Election/Restrictions***

3. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-24, insofar as the claims are drawn to a composition suitable to inhibit the transcription of an oncogene by modulating the binding to double stranded DNA of ESX and a method for treating a subject comprising administering to said subject said composition, wherein said composition comprises at least one polyamide, wherein said at least one polyamide is Her2-1, classified, for example, in class 424, subclass 78.08.

Group II, claim(s) 1-24, insofar as the claims are drawn to a composition suitable to inhibit the transcription of an oncogene by modulating the binding to double stranded DNA of ETS and a method for treating a subject comprising administering to said subject said composition, wherein said composition comprises at least one polyamide, wherein said at least one polyamide is Her2-1, classified, for example, in class 424, subclass 78.08.

Group III, claim(s) 1-24, insofar as the claims are drawn to a composition suitable to inhibit the transcription of an oncogene by modulating the binding to

double stranded DNA of TBP and a method for treating a subject comprising administering to said subject said composition, wherein said composition comprises at least one polyamide, wherein said at least one polyamide is Her2-1, classified, for example, in class 424, subclass 78.08.

Group IV, claim(s) 1-24, insofar as the claims are drawn to a composition suitable to inhibit the transcription of an oncogene by modulating the binding to double stranded DNA of ESX and a method for treating a subject comprising administering to said subject said composition, wherein said composition comprises at least one polyamide, wherein said at least one polyamide is RPR70, classified, for example, in class 424, subclass 78.08.

Group V, claim(s) 1-24, insofar as the claims are drawn to a composition suitable to inhibit the transcription of an oncogene by modulating the binding to double stranded DNA of ETS and a method for treating a subject comprising administering to said subject said composition, wherein said composition comprises at least one polyamide, wherein said at least one polyamide is RPR70, classified, for example, in class 424, subclass 78.08.

Group VI, claim(s) 1-24, insofar as the claims are drawn to a composition suitable to inhibit the transcription of an oncogene by modulating the binding to double stranded DNA of TBP and a method for treating a subject comprising administering to said subject said composition, wherein said composition comprises at least one polyamide, wherein said at least one polyamide is RPR70, classified, for example, in class 424, subclass 78.08.

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4. The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

The special technical feature of group I is a composition suitable to inhibit the transcription of an oncogene by modulating the binding to double stranded DNA of ESX, wherein said at least one polyamide is Her2-1.

The special technical feature of group II is a composition suitable to inhibit the transcription of an oncogene by modulating the binding to double stranded DNA of ETS, wherein said at least one polyamide is Her2-1.

The special technical feature of group III is a composition suitable to inhibit the transcription of an oncogene by modulating the binding to double stranded DNA of TBP, wherein said composition comprises at least one polyamide, wherein said at least one polyamide is Her2-1.

The special technical feature of group IV is a composition suitable to inhibit the transcription of an oncogene by modulating the binding to double stranded DNA of ESX, wherein said at least one polyamide is RPR70.

The special technical feature of group V is a composition suitable to inhibit the transcription of an oncogene by modulating the binding to double stranded DNA of ETS, wherein said at least one polyamide is RPR70.

The special technical feature of group VI is a composition suitable to inhibit the transcription of an oncogene by modulating the binding to double stranded DNA of TBP, wherein said at least one polyamide is RPR70.

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Accordingly, groups I-VI do not share the same or corresponding special technical feature so as to form a single general inventive concept under PCT Rules 13.1 and 13.2.

5. Claims 1 and 13 are linking claims, linking the corresponding inventions of claims 1 and 13, wherein said at least one polyamide is selected from the group of polyamides consisting of (a) Her2-1 and (b) RPR70. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s). Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim depending from or otherwise including all the limitations of the allowable linking claims will be entitled to examination in the instant application. Applicants are advised that if any such claims depending from or including all the limitations of the allowable linking claims are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

6. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

### **Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Rawlings, Ph.D. whose telephone number is (703) 305-3008. The examiner can normally be reached on Monday-Friday, 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony C. Caputa, Ph.D. can be reached on (703) 308-3995. The fax

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phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Stephen L. Rawlings, Ph.D.  
Examiner  
Art Unit 1642



STEPHEN RAWLINGS

slr  
October 1, 2003